

REMARKS

Applicant thanks the Examiner for the withdrawal of the objections to claims 1-13 set forth in a previous Office Action. The present amendment is intended to be fully responsive to the Office Action having a mailing date of October 24, 2007, wherein claims 1-26 have been rejected and are currently pending. By this amendment, claims 27-30 have been added, no claims have been amended and no claims have been canceled. Applicant submits that no new matter has been added by this amendment and that support for new claims 27-30 may be found throughout the specification and drawings, such as in Figure 10 showing a cross-section through the body member.

At least for the reasons set forth below, Applicant respectfully traverses the foregoing rejections. Further, Applicant believes that there are also reasons other than those set forth below why the pending claims are patentable, and reserve the right to set forth those reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers. Applicants respectfully requests reconsideration of the present application in view of the above amendment, the new claims, and the following remarks.

Claim Rejections – 35 U.S.C. § 103

A. Privatera in view of Moore

Claims 1-8 and 14-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Privatera et al. (U.S. Patent No. 6,273,862) in view of Moore (U.S. Patent No. 2,866,457). Applicant respectfully traverses the rejection.

It is well established that “[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). However, Privatera et al, alone or in combination with Moore, fails to teach all of the limitations in claims 1-8 and 14-21.

More specifically, the Examiner contends that Privatera et al. discloses a vacuum assisted biopsy system that communicates saline and/or an anesthetic to a piercer. As admitted by the Examiner, Privatera et al. does NOT disclose a fluid connector that includes two check valves configured to provide two fluids in communication with the biopsy device. The Examiner additionally contends that Moore teaches a fluid connector for the purpose of simplifying and saving time in surgical procedures that includes two check valves for providing fluid communication from one of two fluid sources to an output of the fluid connector. As is evident from reading Moore, and not disputed by the Examiner, Moore is not directed to a biopsy device.

Applicant respectfully requests reconsideration of this rejection in view of the arguments presented below.

As previously presented, Claim 1 positively claims a fluid connector comprising a body member having a first input port in fluid communication with the first fluid source, a first check valve integrated within the body member and in fluid communication with the first input port, a second input port in fluid communication with the second fluid source, a second check valve integrated within the body member and in fluid communication with the second inlet port and an outlet port in fluid communication with the vacuum assisted biopsy device.

As previously presented, Claim 14 claims a body member having a first input port, a second input port and an output port, wherein the first input port includes a first check valve integrated therein and in fluid communication with the first fluid source, the second input port includes a second check valve integrated therein and in fluid communication with the second fluid source and the output port is provided in communication with the vacuum assisted biopsy device.

Privatera et al. certainly does not teach, disclose or suggest a fluid connector comprising a body member with an integral first check valve or an integral second check valve, as expressly claimed by Applicant in Claims 1 and 14.

In the outstanding Office Action, the Examiner states that the fluid connector of Moore includes elements (9, 11, 12, 13 and 22), including tubing that connects check valve 9 to the body

11, and that, as result of that connection, the valves in Moore are integrated into the fluid connector. However, the configuration of Moore still fails to teach or suggest the present invention as claimed in Claims 1 and 14, since, the connector still fails to teach, disclose or suggest a body member with integral first and second check valves. At best, Moore teaches a body member 11 connected by tubing to remote check valves. Indeed, Moore expressly states that the check valves 9 and 22 are connected to a Y-connection via tubing 11 and 21, respectively. See, Col. 1, lines 63-69.

Moreover, Claims 1 and 14 both recite that the first and second inlet ports are integral with the body. However, Moore expressly teaches away from this feature, as it describes the first and second inlet ports as being remote from body member.

The Examiner has asserted in the outstanding Office Action, referring to Moore, that the fluid connector includes “a body member 9, 10, 11,12, 13, 21,22) having a first input port in fluid communication with a first fluid source (6), a first check valve (9) integrated within the body member and in fluid communication with the first input port. The fluid connector further includes a second input port in fluid communication with a second fluid source (26), a second check valve 22 integrated within the body member in fluid communication with the second input port. The fluid connector also includes an outlet port.” Applicant respectfully disagrees. The elements in Moore referred to by the Examiner are not a “body member” as recited in Claims 1 and 14 but a disparate collection of valve housings, fluid lines and joint housing. Furthermore, this large collection of disparate parts do not suggest a body member.

Therefore, Moore and Privatera, either alone or in combination fail to teach or suggest the present invention as claimed in Claims 1 and 14. For at least this reason, the rejection of claims 1 and 14 over Moore and Privatera should be withdrawn.

Furthermore, Privatera nowhere teaches or suggests the desirability of a second port, let alone a second port with a valve, for use in conjunction with a biopsy device. Moore is not a biopsy device and therefore also fails to suggest nor teach the desirability of a second port, let alone a second port with a valve, for use in conjunction with a biopsy device. Since neither of the

references suggests or teaches this claimed feature of claims 1 and 14, they cannot alone or in any combination teach or suggest this feature. For at least this additional reason, the rejection of claims 1 and 14 over Moore and Privatera should be withdrawn.

Claims 2-8 are dependant upon claim 1 and therefore include all of the limitations of Claim 1 that distinguish Claim 1 from Moore and Privatera. Similarly, Claims 15-21 are dependant upon claim 14 and therefore include all of the limitations of Claim 14 that distinguish Claim 14 from Moore and Privatera. For at least this reason, the Examiner is respectively requested to withdraw the rejection of Claims 1-8 and 14-21 under 35 U.S.C. 103(a) over Privatera in view of Moore.

Furthermore, the dependent claims each contain additional features that are also not found in either reference.

Claims 3 and 16 require the second check valve to include a resiliently compressible valve member. While the Examiner states that the check valves of Moore “comprise resiliently compressible valve members (around and including spring 25 in figure 1) secured in a valve seat (around 25 in figure 1)”, Moore teaches a valve member (disc 31) biased into position by a spring (25). (Moore Col. 2, lines 24-28). No where does Moore state that the valve member of Moore itself may be resiliently compressible. The Examiner merely argues that Moore’s valve member is resilient by referring to the valve member as including the elements “around and including spring 25”, but defining the spring into the term valve member is an improper retrospective reconstruction of the teaching of Moore. Moore nowhere teaches or suggests resiliency in the component that actually performs the valving function – the disc 31 – but instead explicitly teaches that the valve member requires a second component to bias it into position. For this additional reason, claims 3 and 16 should be allowed. The Examiner has not responded to this argument in the outstanding Office Action but has merely repeated the previously stated grounds of rejection. Applicant respectfully requests that the Examiner allow these claims or provide such a response.

Claims 8 and 21 recite that first check valve exhibits a predetermined cracking pressure. The Examiner has asserted that the check valves taught by Moore

inherently have a predetermined cracking pressure. The Examiner has cited no reference or authority for this principle. There is no explicit discussion of this feature in Moore or in Privatera. Applicant respectfully requests the Examiner to provide such reference or authority or withdraw this rejection.

Claims 9, 10, 22 and 23 recite further limitations relating to the cracking pressure in comparison with other characteristics of the overall system. For example claim 9 recites that “the cracking pressure is less than or equal to a pressure resulting from a vacuum created in the fluid connector by the vacuum assisted biopsy device” and claim 10 recites that “the cracking pressure is greater than a pressure resulting from a vacuum created in the fluid connector by the vacuum assisted biopsy device when the second check valve is open.” Moore neither teaches nor suggests these claimed limitations on the cracking pressure. Even if the Examiner is correct in stating that the valve in Moore exhibits a predetermined cracking pressure, there is nothing inherent in the drawings or specification of Moore about the level of such cracking pressure. For this additional reason, this rejection of claims 9, 10, 22 and 23 should be withdrawn.

B. Privatera in view of Moore and Turturro

Claims 11, 13, 24, and 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Privatera et al. (U.S. 6,273,862) as modified by Moore (U.S. 2,866,457), as applied to claims 1-8 and 14-21 above, and further in view of Turturro et al. (U.S. 6,331,165), newly cited. Applicant respectfully traverses the rejection.

The examiner states that “Turturro teaches luer fittings (column 18, lines 33-41) for the purpose of providing quick and easy connection and disconnection.”

However, Turturro does not make up for the deficiencies in the teachings of Privatera and Moore described above. Turturro nowhere teaches, discloses or suggests the elements of a fluid connector comprising a body member with an integral first check valve or an integral second check valve, as claimed by Applicant in each of these claims. Therefore, for at least the reasons stated

above, Claims 11, 13, 24, and 26 are allowable over any combination of Tuturro, Privatera and Moore.

C. Miller in view of and Moore

Claims 1-10, 12, 14-23 and 25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Miller 35 al. (U.S. 2002/0082519) in view of Moore (U.S. 2,866,457). Applicant respectfully traverses the rejections.

The Examiner admits that, while Miller teaches a vacuum assisted biopsy device having a first fluid source with a first check valve, it does not illustrate a second fluid source. Indeed, the Examiner then proceeds to state that a second fluid source “is possible”. However, Moore does not teach or suggest how that second fluid source is provided, and therefore neither teaches nor suggests a second check valve for the second fluid source.

Further, as described above, independent claims 1 and 14 recite a body member having a first input port, a second input port, a first check valve and a second check valve integrated therein. Each of Claims 2-10, 12, 15-23 and 25 are dependant on either claim 1 or claim 14 and therefore also include this feature. Miller nowhere teaches or suggests a second check valve. Miller nowhere teaches or suggests a body member having a first and a second input port. Miller nowhere teaches or suggests a body member with two check valves integrated therein.

Nor does Moore provide the claimed features that are missing in Miller. The Examiner states that Moore has a fluid connector including “two check valves (9, 11) for providing fluid communication from one of two fluid sources (6, 26) to an output of the fluid connector.” However, for the reasons presented previously, Moore nowhere teaches or suggests a body member having a first and a second input port and a first and a second check valve integrated therein. Therefore, for at least the reasons stated above, 1-10, 12, 14-23 and 25 are allowable over any combination of Moore and Miller.

For at least this reason, the rejection of claims 1 and 14 over Miller and Moore should be withdrawn.

Claims 2-10 are dependant upon claim 1 and therefore include all of the limitations of Claim 1 that distinguish Claim 1 from Moore and Miller. Similarly, Claims 15-23 and 25 are dependant upon claim 14 and therefore include all of the limitations of Claim 14 that distinguish Claim 14 from Moore and Miller. For at least this reason, the Examiner is respectfully requested to withdraw the rejection of Claims 2-10, 12, 15-23 and 25 under 35 U.S.C. 103(a) over Miller in view of Moore.

Furthermore, the dependent claims each contain additional features that are also not found in either reference. For example, for the reasons described above, Moore fails to teach or suggest the resiliently compressible valve member claimed in claims 3 and 16, the predetermined cracking pressure of claims 8 and 21, and the relative level of the cracking pressure of claims 9, 10, 22 and 23. Miller adds no relevant disclosure which would teach or suggest any of the features. For at least this additional reason, the rejection of these claims over Moore and Miller should be withdrawn.

New Claims 27-30

New claims 27-30 have been added, respectively dependent, either directly or indirectly, upon claims 1 and 14. New claims 27 and 28 recite a body member comprising a housing with a fluid passageway therethrough communicating with the input and outlet ports. Since these claims include all of the limitations of the claims upon which they depend, they are allowable at least for the reasons presented above. Support for this amendment may be found in at least FIG. 10. Furthermore, new claims 27 and 28 each contain additional features that are also not found in any reference.

As described above, Applicant respectfully disagrees with the Examiner's assertion that Moore has a body member as claimed in claims 1 and 14. Claims 27 and 28 are further distinguishable from the cited prior art as they recite that the body member has a housing having

each of the 3 ports and a passageway connecting them. Moore has multiple independent housings, one for each of the ports, connected together by flexible tubing. Therefore Moore neither teaches nor suggests the housing claimed in new claims 27 and 28. New claims 29 and 30, which are also supported by at least FIG. 10, recites that the body member is a unitary member. This feature is also not taught in any of the cited prior art.

For at least this additional reason, these new claims are allowable over Moore, either alone or in any combination with Miller, Privitera, and/or Turturro.

CONCLUSION

Reconsideration and allowance are respectfully requested. In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Authorization for the fee for the additional claims added by this amendment accompanies this response. However, if any additional fee is due, please charge our Deposit Account No. 18-0013, under Order No. 65937-0045 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. § 1.136 is hereby made, the fee for which should be charged to such deposit account number.

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